

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN J. DAVIS and ANDRE TERZAGHI

Appeal No. 96-3643
Application 29/008,022¹

HEARD: August 5, 1997

Before MEISTER, SMITH, and THIERSTEIN, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is a decision on appeal from the following design claim:

The ornamental design for a tennis racquet as shown and described.²

¹ Application for patent filed May 6, 1993. According to the appellants, the application is a division of 07/988,579, filed December 10, 1992.

² The claimed design encompasses three separate embodiments as depicted in Figs. 1-3. In the first Office action (Paper No. 4) the examiner held that these figures were multiple embodiments (continued...)

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The reference relied upon by the examiner is:

Bell Catalog Racket "C" (p. 363) 1980

The claim stands rejected under 35 U.S.C. § 102(b) as being clearly anticipated by the Bell Catalog³ and 35 U.S.C. § 103 as being unpatentable over the Bell Catalog.

The examiner's rejections are explained on pages 3 and 4 of the answer.

OPINION

Having carefully considered the respective positions advanced by the appellants in the brief and supplemental brief and by the examiner in the answer and supplemental answer, it is our conclusion that neither of the above-noted rejections is sustainable.

Considering first the rejection under 35 U.S.C. § 102(b), we initially note that the "ordinary observer" test (as distinguished from the "ordinary designer" test used in determining obviousness under 35 U.S.C. § 103) is applicable in

²(...continued)
of a single inventive concept within the meaning of ***In re Rubinfield***, 270 F.2d 391, 123 USPQ 210 (CCPA 1959), ***cert. denied***, 362 U.S. 903 (1960).

³ This rejection was set forth as a new ground of rejection in the answer.

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determining the presence of novelty under § 102. **See In re Nalbandian**, 661 F.2d 1214, 1216, 211 USPQ 782, 785 (CCPA 1981). With respect to the "ordinary observer" test for determining whether novelty is present under § 102 the court in **In re Barlett**, 300 F.2d 942, 943-44, 133 USPQ 204, 205 (CCPA 1961) set forth (in quoting with approval from Shoemaker, **Patents for Designs**, page 76):

If the general or ensemble appearance-effect of a design is different from that of others in the eyes of ordinary observers, **novelty** of design is deemed to be present. The degree of difference required to establish **novelty** occurs when the average observer takes the new design for a different, and not a modified already-existing, design.

It therefore follows that, in order to establish lack of novelty (i.e., anticipation), the ordinary observer must take the general or ensemble appearance-effect of the design under consideration to be the same as that of an already-existing design (even though a degree of difference may actually be present).

Here, we are of the opinion that the ordinary observer would take the appellants' design to be a different design from that shown in the Bell Catalog. The different overall impressions created by tennis racquet "C" of the Bell Catalog and that of the

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appellants' tennis racquet would be readily appreciated by an ordinary observer such as a purchaser. Specifically, the ordinary observer would readily discern the differences in appearance of the throat block, the relative bulk of the frames and the overall general proportions of the two designs. This being the case, we will not sustain the rejection of the design claim on appeal under 35 U.S.C. § 102(b) as being clearly anticipated by the Bell Catalog.

We now turn to the rejection under 35 U.S.C. § 103. As we have noted above, the "ordinary designer" test is used in determining obviousness under § 103. That is, "[t]he test for determining obviousness of a claimed design under 35 U.S.C. § 103 is whether the design would have been obvious to a designer of ordinary skill who designs articles of the type involved" (*In re Carter*, 673 F.2d 1378, 1380, 213 USPQ 625, 626 (CCPA 1982)). That inquiry focuses on the visual impression of the claimed design as a whole and not on selected individual features. *In re Borden*, 90 F.3d 1570, 1574, 39 USPQ2d 1524, 1526 (Fed. Cir. 1996).

In order to support a holding of obviousness under § 103, there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed

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design. Such a reference is necessary whether the holding is based on the basic reference alone or on the basic reference in view of modifications suggested by secondary references. **See In re Rosen**, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

Here, we believe the examiner's selection of the Bell Catalog to be the basic reference was appropriate inasmuch as tennis racquet "C" depicted therein bears such a close over-all similarity in appearance to the appellants' design as to satisfy the **Rosen** requirement of an ornamental design which is "basically the same as" the claimed design.

We do not, however, believe that it would have been obvious from a design or appearance standpoint to make the necessary modifications to arrive at the appellant's design. **See In re Cho**, 813 F.2d 378, 382, 1 USPQ2d 1662, 664 (Fed. Cir. 1987).

The main thrust of the examiner's position is that:

The present claimed design is a racket of the old monoshaft style with a larger head and slimmer throat area. Appellant states that since the 1970's rackets were introduced with a proportionally longer and wider head. In fact Appellant claims three embodiments in his application the difference being the size of the head. This in itself shows that to modify the size of the head is a well known

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design expedient to one of ordinary skill in the art. The Bell catalog page also discloses various tennis rackets with varying throat widths which shows that this change in size is obvious.

Appellant asserts that the "Bell racket head is smaller and has a larger aspect ratio (length/width) and the shaft is longer in comparison with the claimed design. Also, the shaft and head frame portions are thinner in the claimed design than the frame of the Bell racket "C". Again these differences are minor changes in proportions or sizes and are not seen to be patentable advances in the racket art. *In re Stevens*, [173 F.2d 1015,] 81 USPQ 362 [(CCPA 1949)], was cited to support the Examiner's contention that changes in proportions was obvious and not a basis for patentability. [Answer, pages 4 and 5.]

From the above it is readily apparent that the examiner recognizes that significant differences exist between the claimed design and that of tennis racquet "C" of the Bell Catalog but, nevertheless, seeks to dismiss such differences as changes in proportion that are "obvious and not a basis for patentability," citing *Stevens* as authority. To the extent that the examiner is attempting to extract from *Stevens* a hard and fast rule that all changes in proportion are *per se* unpatentable advances, we are of the opinion that the examiner's reliance upon this authority is misplaced inasmuch as the court therein made it clear that the changes in proportion there involved did not result in an overall appearance which was substantially different.

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As the court in *In re Blum*, 374 F.2d 904, 907, 153 USPQ 177, 179-180 (CCPA 1967) stated:

there are **no** portions **of a design** which are "immaterial" or "not important." A design is a unitary thing and all of its portions are material in that they contribute to the appearance which constitutes the design.

The appearance may be the result of a peculiarity of configuration, or of ornamentation, or of both. *See Gorham Mfg. Co. v. White*, 81 U.S. (14 Wall.) 511, 525 (1872) and *In re Schnell*, 46 F.2d 203, 209, 8 USPQ 19, 25 (CCPA 1931). In light of these authorities, it is apparent that it is the appearance of the design as a whole which must be considered and, therefore, to the extent that proportions and shape of a design contribute to the overall visual effect, they must be taken into consideration. *Cf. Lee v. Dayton-Hudson Corp.*, 838 F.2d 1186, 1188, 5 USPQ2d 1625, 1627 (Fed. Cir. 1988) wherein our reviewing court (in considering the infringement of a design patent) stated

the district court correctly viewed the design aspects of the accused devices: the wooden balls, their polished finish and appearance, the **proportions**, the carving on the handle, and **all other ornamental characteristics**, considered to the extent

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that they would be considered by "the eye of an ordinary observer", **Gorham**, 81 U.S. (14 Wall.) at 528. [Emphasis ours.]

Here, we are of the opinion that the differences in appearance of the throat block, the relative bulk of the frames and the overall general proportions of the appellants' design produces an overall visual effect which is not suggested by tennis racquet "C" of the Bell Catalog. Perhaps each of the differences noted by the examiner by itself is a minor difference, but taken together the net result is a distinctly different appearance. **See *In re Laverne***, 356 F.2d 1003, 1007, 148 USPQ 674, 677 (CCPA 1966).

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The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JERRY SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOAN THIERSTEIN)	
Administrative Patent Judge)	

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APPLICATION NO. 29/008,022

APJ MEISTER

APJ SMITH, JERRY

APJ THIERSTEIN

DECISION: **REVERSED**

Typed By: Jenine Gillis

DRAFT TYPED: 25 Nov 98

Revision: 18 Aug 97

FINAL TYPED: